UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,660	11/29/2001	Won Sik Kim	K-0347	2627

34610	7590	05/23/2006	

FLESHNER & KIM, LLP
P.O. BOX 221200
CHANTILLY, VA 20153

EXAMINER
LAZARO, DAVID R

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Advisory Action **_Before the Filing of an Appeal Brief_**	Application No.	Applicant(s)
	09/995,660	KIM, WON SIK
	Examiner	Art Unit	
	David Lazaro	2155	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>20 April 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>6</u> months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

      Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☒ The Notice of Appeal was filed on *<u>20 April 2006</u>*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

      NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *<u>none</u>*.

   Claim(s) objected to: *<u>none</u>*.

   Claim(s) rejected: *<u>1-21</u>*.

   Claim(s) withdrawn from consideration: *<u>none</u>*.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: <u>See Continuation Sheet.</u>
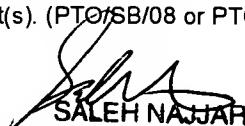
SALEH NAJJAR
SUPERVISORY PATENT EXAMINER
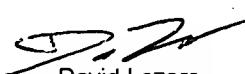
David Lazaro
May 16, 2006

Continuation Sheet

Continuation of 11:

Applicant argues on page 9 of the remarks - "...*applicant respectfully submits that at least FIG. 4 and paragraphs [46]-[49] of the present specification correspond to the features relating to the determining module....Applicant respectfully submits that based on the well-known ICMP being part of a TCP/IP standard, one skilled in the art would clearly know how to make and/or use the claimed determining module as recited in independent clam 1...Stated differently, one skilled in the art would have been capable of receiving a reply to an ICMP ping packet and determining features of the received message (based on understanding of ICMP messages, for example).*"

Examiner's response - The examiner first notes that while FIG. 4 and paragraphs [46]-[49] states the features related to the determining module, there is no description of how the features are specifically implemented such that one of ordinary skill in the art could make and/or use the claimed feature. There are two specific points the examiner will attempt to clarify.

The first point relates back to the examiners question of whether a reply to a ping may be received from the same client that issues a request for an IP address allocation. Based on the information provided in the specification, it is the examiner's understanding that if a DHCP client is making a request for an IP address allocation, then the DHCP client does not currently have an allocated IP address. Accordingly, the claim language appears to convey the limitation that a client requesting an IP address allocation does not currently have an allocated IP address (MPEP 2111). Applicant relies in part on an understanding of RFC 792, "Internet Control Message Protocol (ICMP), as the basis of enablement. Page 14 of RFC 792 describes the echo and echo

reply formats which make up the ping messages. The format includes a source and destination address field. In the case of the claimed subject matter, the destination address of the initial echo message of the ping will be the IP address that may potentially be allocated. But if the DHCP client requesting an IP address allocation does not have an allocated IP address, how can it respond to a message with a destination IP address. The specification does not describe how a DHCP client without an IP address could respond to a message that uses an IP address to designate the destination of the message. It would seem that if an DHCP client could respond to a ICMP echo message which uses an IP address as the destination address, then the DHCP client is already allocated an IP address. The specification does not mention any scenario or embodiment where a DHCP client is already configured with an IP address but is still requesting allocation of an IP address.

Even taking into consideration that a DHCP client requesting an IP address allocation can indeed respond to a ICMP ping, the second point the examiner brings attention to is the actual determination functionality. Specifically, the specification offers no description or explanation of how the determining module can specifically distinguish between a response from a requesting DHCP client and a response for another DHCP client. As noted before, Applicant relies in part on the understanding of RFC 792, and that such an understanding provides for enabling determining features. However, while DCHP provides the use of a client identifier to provide a way to distinguish between DHCP clients (Page 9 of RFC 2131), the cited RFC 792 does not provide such a feature that allows to distinguish between hosts/clients other than the source and destination

address. Clearly if any response is received from an echo message, it will be a

response from the IP address that was used in the destination address of the echo

message. But RFC 792 does not describe any way of determining if that response was

from the DHCP client requesting an IP address allocation or from another DHCP client.

From an ICMP point of view, the response is merely indicative of a node that is currently

operating at that particular IP address. This is expressed in applicant's specification on

Page 8, paragraph [34]. So while the specification makes the statement of a feature

that distinguishes, it is not clear, even from the basis of understanding ICMP, as how

one of ordinary skill in the art could make and/or use such a feature.

Applicant argues on page 9 of the remarks - "*The Office Action (on at least page 2)*
questions whether a reply to a ping may be received from the same client that issues a
request for an IP address allocation. See paragraph [46], last three lines."

      Examiner's response - Paragraph [46], last three lines, only makes a statement

of the feature. It does not address the issue of implementation of the feature such that

one of ordinary skill can make and/or use the feature.

Applicant argues on page 11 of the remarks - "*...these sections do not relate to both a*
reply from the DHCP client and/or a reply from the another DHCP client. In other
words, JOIN does not distinguish between a DHCP client and another DHCP client an
perform different operations based on the different clients."

      Examiner's response - JOIN clearly describes that the server can distinguish a

ping response received from a requesting DHCP client (Page 6 - BOOTP Client Lease

Extension) versus a ping response from another DHCP client (Page 8 - Ping BOOTP

Clients). Furthermore, as described on Page 6, BOOTP Client Lease Extension, the

examiner considers the extension of the lease to be a "DHCP procedure using

registered relevant event information". As described on page 8, Ping BOOTP Clients

and Ping Timeout", the examiner considers the marking of the address as unavailable

and the use of a new address from the address pool as "changing the registered

relevant event information".

Continuation of 13:

The rejections of Claims 1-21 are maintained as presented in the 10/20/2005 Office

Action.